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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,578	03/18/2004	Claus-Jurgen Maier	DEAV2003/0026US NP	6155

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EXAMINER

REYES, HECTOR M

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/803,578

Applicant(s)

MAIER ET AL.

Examiner

Hector M. Reyes

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1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 in part is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 6 and 8 is/are rejected.
- 7) ☒ Claim(s) 1-5 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/18/04.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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**DETAILED ACTION**

**ELECTION**

The Examiner acknowledges Applicant's non-traversing Election of Group II, claims 1-4 in part drawn to nonheterocyclic derivatives embraced in 1-4 and method of using the same as described in claims 5-8 in part dated on January 11, 2005.

**Status of The Claims**

Claims 1-4 in part drawn to nonheterocyclic derivatives as well claims 5-8 in part drawn to a method of using the said elected nonheterocyclic derivatives are under Examination. Nonelected subject matter is hereby withdrawn from consideration.

**Claims Objected**

Claims 1-4 and 5-8 are hereby objected because the said claims contains nonelected subject matter: heterocyclic derivatives embraced in claims 1-4 and its further use as described in claims 5-8 is nonelected subject matter.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The use of a compound is not a statutory subject matter.

Is Applicant intention to claim a method?

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, the phrase "suitable base" is indefinite because it is unclear what bases may or may not be "suitable" or embraced by the said phrase. In claim 6, the word "NMP", presumably related to a solvent is indefinite because it is unclear what particular solvent Applicant is intending to include in the said method's description. The Examiner suggests the inclusion of the solvent name.

### **ALLOWABLE SUBJECT MATTER**

Chlorine derivatives embraced in instant claims 1-4 have not been found disclosed in the prior art. However, the corresponding bromine derivatives have been found in the prior art, see for instance US patent 4585788 disclosing the methyl ester of benzoic acid 2-bromomethyl-6-methyl, having a registry number 56427-77-1 and more particularly Applicant's disclosure on page 2 of the instant specification.

Applicant also acknowledges that the bromine derivatives have been use in the preparation of derivatives (C ), see pages 2-3 of the instant specification. However, Applicant also disclosed that the claimed chlorine derivatives contains different

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properties when compare to their bromide analogous derivatives, see page 8 of the instant specification, wherein the stability in the purification process and shelves lives of both derivatives is discussed. Thus, the claimed chlorine derivatives are not considered as suggested over the prior art disclosing the said bromine analogous compounds.

### CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector M Reyes whose telephone number is (571) 272-0691. The examiner can normally be reached on M-F (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Cecilia Tsang, can be reach at 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hector M. Reyes PhD JD  
USPTO Reg. # P-54,846  
Au 1625  
March 12, 2005

Ms. Cecilia Tsang  
Patent Examiner Supervisor

  
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